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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,125	04/19/2000	Joseph M. Cannon	1298/OF148	3933

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EXAMINER

KIDD, MARKY M

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 02/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/553,125

Applicant(s)

CANNON ET AL.

Examiner

Marky M Kidd

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) 1 and 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 April 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show Transmitter 60 (page 6 line 17) as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Transmitting Circuit (Figure 5). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 2** recites the limitation "conventional Caller ID service". There is insufficient antecedent basis for this limitation in the claim. In claim 2, line 4 the claim states "conventional Caller ID service"; however, in the specifications there is not clarification of what exactly "conventional Caller ID service" is considered to be. It is well known in the art that with the rapid development of telecommunications that what may be considered conventional at this time

will not be considered conventional in years to come. Therefore, applicant needs to clarify what is meant by "conventional Caller ID service".

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Latter et al (US Patent Number 6,178,232) in view of Hoopes (US Patent Number 5,905,786).

Regarding **claim 1 and 4**, Latter discloses a method for communicating an audio message (audible caller identification information) between a calling telephone apparatus (calling communication station 40) and a called telephone apparatus (called communication station 30) apparatus remains in an on-hook state and each telephone apparatus being connected to a telephone system consist of the following step of introducing a digitized version (column 3, lines 19-22) of the audio message (audible caller identification information) to the called telephone apparatus (called communication station 30, column 2 lines 48-59 and lines 32-35). Latter is silent on the issue of the digitized version of the audio message being introduced during the silent interval following the second ringing signal. It is old and well known to transmit digitized voice messages in a telephone system. Further, it is well known in the art that caller id of the called party is transmitted during the silent interval between the first and second ring. Hoopes discloses a system for where different incoming ring signals can be created for a telephone device (column 2, lines 26-28 and lines 36-38). The called party can program the system to ring

and transmit information to the telephone device until a determination of how the call is to be handled has been decided. Hoopes discloses the FSK frequencies that sends data to a telephone during different phases of telephone operation, which includes ringing patterns (column 3, lines 66-67 and column 4, lines 1-4). Hoopes further discloses the pattern of ringing signals with Caller ID information that consist of a pattern of a first ring, a gap (pause), a second ring, followed by another gap (pause). This pattern continues until there is a disconnect or answer of the call (column 4 line 67 and column 5 lines 5). It would have been obvious to one skilled in the art at the time of the invention to modify the method of Latter to include the method of Hoopes in order to allow the digitized version of the audio caller id message to be introduced during the silent interval following the second ringing signal.

6. **Claims 7 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Latter in view of Doughty (US Patent Number 4551,581).

Regarding **claims 7 and 10**, Latter discloses an apparatus for communicating an audio message (audible caller identification information) between a calling telephone apparatus (calling communication station 40) and a called telephone apparatus (called communication station 30) while the called telephone apparatus remains in an on-hook state (column 1, lines 66-67 and column 2, lines 1-8). Latter also discloses a receiver for receiving a digitized version of the audio message (column 2, lines 48-59 and column 5, lines 34-35) and a digital-to-analog converter (SS7 Signaling technique) for converting the digitized version of the audio message to an audio version (column 3, line 18-22), which will be produced over a transducer (column 2, line 57-59). It is well known in the art that the audio caller identification information will be transmitted during the silent interval of the ringing cycle of the call. Therefore, it is obvious that

Art Unit: 2645

some type of signal injector and silence detector (column 5, line 34) is implemented in the system of Latter. However, Latter does not go into details of how this is performed. Doughty discloses an apparatus that sends data messages to a called telephone apparatus during a silent interval between ringing (column 1, lines 56-59). The apparatus is able to detect the number of rings (column 11 line 12) and the silent intervals (column 11, line 35). The apparatus is equipped with a ring detector (column 13, line 48-49), and a "silent interval detect" state (column 13, lines 55-57). Therefore, it would have been obvious to one skilled in the art to modify the apparatus of Latter to include the detections of silent intervals of Doughty in order to allow the audible caller identification to be sent during the second ringing signal.

7. Claims **3 and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Latter in view of Hoopes in further view of Doughty.

Regarding **claims 3 and 6**, Latter modified by Hoopes disclose all the limits as set forth in claim 1. However, Latter and Hoopes are silent on the issue of the audio message having sufficient duration to extend beyond the silent interval. Doughty discloses system that is able to detect the duration of silent intervals. The data message is comprised of all necessary information necessary to transmit the message upon detection of a silent interval (column 13, lines 3-9 and column 14, lines 20-32). Therefore, it would of have been obvious to one skilled in the art with the method of Latter, as modified by Hoopes, and further modified by Doughty in order to use the method of Doughty so that sufficient duration of a message during the silent interval is used.

8. **Claims 2 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Latter in view of Hoopes and further in view of Cannon et al (US Patent Number 6,353,664).

Art Unit: 2645

Regarding **claims 2 and 5**, Latter as modified by Hoopes disclose all the limits as set forth in claim 1. However, Latter and Hoopes are silent on the issue of Caller ID service available during the silent interval following the first ringing signal to the called telephone apparatus in addition to the audio message. Cannon discloses customer premise equipment that provides the identity of the calling party to the called party (column 1, lines 62-65). The customer premise equipment disclose is Type 1; therefore, when on-hook the identity of the calling party is displayed during the silent interval between the first and second ring (column 2, lines 58-62). It would have been obvious at the time of the invention to modify the method of Latter, as modified by Hoopes, to include the method of Cannon to allow more than one way for the called party to identify and screen incoming calls. Also if the called party isn't at home during the time of the call with the customer premise caller id equipment the called party can check who called while out.

9. **Claims 8, 9, 11 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Latter in view of Doughty in further view of Cannon.

Regarding **claims 8 and 11**, Latter and Doughty disclose all the limits as set forth in claim 1. Latter and Doughty are silent on the issue of providing a signal identifying the calling party during the silent interval following the first ringing signal to the called telephone device, which provides conventional Caller ID service along with the audio message. Cannon discloses a customer premise equipment that provides the identity of the calling party to the called party (column 1, lines 62-65). The customer premise equipment disclosed is Type 1; therefore, when on-hook the identity of the calling party is displayed during the silent interval between the first and second ring (column 2, lines 58-62). It would have been obvious at the time of the invention

Art Unit: 2645

to modify the method of Latter and Doughty to include the method of Cannon to allow more than one way for the called party to identify and screen incoming calls.

Regarding **9 and 12**, Doughty discloses a method and apparatus wherein the digitized version of the audio signal is presented during the silent interval and beyond as necessary (column 13, lines 3-9 and column 14, lines 20-32).

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marky M Kidd whose telephone number is 703-305-8149. The examiner can normally be reached on Monday-Friday 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5403 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

Marky M Kidd  
Examiner  
Art Unit 2645

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February 10, 2003

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
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